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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/605,226

09/16/2003

Stephen J Brown

7553.00110 / 03-0910

2225

60683 7590 12/15/2009
HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER

FUELLING, MICHAEL

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

12/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/605,226	Applicant(s) BROWN, STEPHEN J	
	Examiner Michael Fuelling	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-234 is/are pending in the application.
- 4a) Of the above claim(s) 88-234 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/16/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :09/03/2008; 07/16/2008 and 06/23/2004.

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DETAILED ACTION

This is a non-final, first office action on the merits for Application Number 10/605,226 filed 09/16/2003.

Claims 1-234 are pending.

Claims 88-234 have been withdrawn.

Claims 1-87 have been amended.

Claims 1-87 currently are pending and have been examined.

Election/Restrictions

Applicant's election of claims 1-87 with traverse is acknowledged. Applicant did not respond to all of the reasons for the restriction requirement. For example, applicant did not contest the separate classification of the inventions. According to the MPEP, separate classification of inventions constitutes a serious search burden. See MPEP 808.02. Accordingly, the restriction requirement is deemed proper and made FINAL.

Information Disclosure Statements

The information disclosure statements submitted on 09/03/2008; 07/16/2008 and 06/23/2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner. Applicant is advised to point out the references and pages that are most relevant when submitting jumbo information disclosure statements like the 06/23/2004 information disclosure statement submitted in this case.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “remote patient sites” having a “display”, a “unit” with a “server”, a “memory” and a “monitoring device” must be shown or the feature(s) canceled from the claim(s). Fig. 2 shows only “patients” (58) with a “server” (54). No figure shows a “remote patient site” having the claimed features. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1-87 are objected to because of informalities. For example, claims 1, 44 and 87 include bullet point symbols. Appropriate corrections are required.

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Claim 87 includes multiple “means” elements, such as a “data management unit means” and “memory means”, that invoke 35 U.S.C. 112, sixth paragraph. The written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed function.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites “including • at least one display” and “for display on at least one display”. It is unclear whether these are the same display or not. Claims 2-43 do not cure the defect. It is being interpreted that there could be multiple displays.

Claim 44 recites “ • using * * * at least one display” and “for display on at least one display”. It is unclear whether these are the same display or not. Claims 45-86 do not cure the defect. It is being interpreted that there could be multiple displays.

Claim 87 recites “• means for displaying” and “means for * * * for display on at least one display”. It is unclear whether these are the same display or not. It is being interpreted that there could be multiple display means.

Claim 43 recites “the health care professional computer” and there is insufficient antecedent basis for this limitation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-19 and 21-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claim 1 recites a “memory” which reasonably could be interpreted to be that of the “health care professional” as the memory element is not clearly linked to other computer elements, and people are not statutory subject matter. Claim 20 cures the defect.

Additionally, claim 38 recites “enable programs to be provided”. In light of the specification’s multiple uses of the word “signal”, it reasonably could be interpreted that these “programs” are signals, and data signals and carrier waves are non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. Claims 1-13, 15, 16, 21, 22, 38-42, 44-56, 58, 59, 64-66, 81-85 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu et al., US Patent No. 4,803,625 (Fu) in view of Kirk et al., US Patent No. 5,390,238 (Kirk).

As per claims 1, 44 and 87, Fu discloses a system and method, the method comprising:

- *at a plurality of remote patient sites (Fig.1)*
 - *facilitating collection of patient health-related data using a data management unit (80);*
 - *using stored program instructions to generate health-monitoring related information on at least one display (68); and*
 - *collecting patient-health related data (Fig. 1)*
- *connecting at least one central server for communication with the data management units at the patient site (Fig. 1)*

Fu does not appear to expressly disclose:

- *transmitting message for display on at least one display in which at least one message is a health care professional selected message*

Kirk teaches this messaging feature (Figs. 1-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Fu to include a messaging feature because it is the combination of known elements and the results would have been predictable.

As per claims 2-10, 22, 44-53, 65 and 66 Kirk teaches various messaging / reporting options (columns 3-5).

As per claims 21 and 64, Fu further discloses a computer (64).

As per claims 11-13, 15, 16, 54-56, 58, and 59, Fu discloses monitoring devices (60).

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As per claims 38-42 and 81-85, Fu discloses computer programs and collection of various data (Abstract).

4. Claims 14 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, in view of Kirk, in further view of Fujimoto, US Patent No. 5,339,821 (Fujimoto).

Fu and Kirk do not appear to expressly disclose or teach operational buttons, and Fujimoto teaches such (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of Fu, as modified by Kirk, to include operational buttons because it is the combination of known elements and the results would have been predictable.

5. Claims 17-19 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, in view of Kirk, in further view of Beckers, US Patent No. 5,019,974 (Beckers).

Fu and Kirk do not appear to expressly disclose or teach handheld devices with graphical displays, and Beckers teaches such (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of Fu, as modified by Kirk, to include handheld devices with graphical displays because it is the combination of known elements and the results would have been predictable.

6. Claims 20, 43, 63 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, in view of Kirk, in further view of Official Notice.

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Fu and Kirk do not appear to expressly disclose or teach a memory cartridge or authorization codes. The examiner takes Official Notice that such elements are old and well known in the computer arts. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of Fu, as modified by Kirk, to include these features because it is the combination of known elements and the results would have been predictable.

7. Claims 23-32 and 67-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, in view of Kirk, in further view of Lee, US Patent No. 4,838,275 (Lee).

As per claim 23, Fu and Kirk do not appear to expressly disclose or teach:

- one health care professional computer, remotely located from and in signal communication with the central server to receive the reports

Lee teaches such a remote computer (118a).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of Fu, as modified by Kirk, to include a remote computer because it is the combination of known elements and the results would have been predictable.

As per claims 24-32 and 67-75, Lee evidences that standardized and statistical reports are old and well known.

8. Claims 33-37 and 76-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, in view of Kirk, in further view Dessertine, US Patent No. 5,016,172 (Dessertine).

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Fu and Kirk do not appear to expressly disclose or teach a user's selection of portions of displays, and Dessertine teaches such (columns 3 & 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of Fu, as modified by Kirk, to allow a user's selection of portions of displays because it is the application of known technique to a known system and method and the results would have been predictable.

Double Patenting

I. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-87 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-87 of copending Application No. 11/362,041. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

II. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 11, 54 and 87 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6, 24 and 1, respectively, of Brown, U.S. Patent No. 7,624,028.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11, 54 and 87 of this application include all of the limitations of claims 6, 24 and 1, respectively, of the above-identified patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Fuelling whose telephone number is (571)270-1367. The examiner can normally be reached on Monday - Friday, 8:30 am - 5 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571)272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Fuelling/
Examiner, Art Unit 3626

/Robert Morgan/
Primary Examiner, Art Unit 3626